

REMARKS

Claims 1 and 3-27 were examined. Claims 28-30 are canceled. Claims 1 and 3-27 remain in the Application.

The Patent Office requests cancellation of non-elected claims. The Patent Office rejects claims 1 and 3-12 under 35 U.S.C. §103(a). The Patent Office finds claims 13-27 allowable. Reconsideration of the pending claims is respectfully requested in view of the above amendments and the following remarks.

A. Election/Restrictions

The Patent Office requests cancellation of non-elected claims 28-30. Claims 28-30 are canceled.

B. 35 U.S.C. §103(a): Rejection of Claims 1, 3-6, 8-9 & 11

The Patent Office rejects claims 1, 3-6, 8-9 and 11 under 35 U.S.C. §103(a) as obvious over U.S. Patent No. 5,876,373 of Giba et al. (Giba) in view of U.S. Patent No. 6,327,492 of Lemelson (Lemelson). Giba is cited for disclosing a substance delivery system having a handle, a flexible body portion, a flexible element, a braid, an anchor element, a tendon (shim 120) and a location sensor. Lemelson is cited for suggesting a tendon coupled to an electrical interface. Figure 4 and col. 19, line 18 through col. 20, line 18 are cited for this suggestion.

Independent claim 1 is not obvious over the cited references, because the cited references fail to teach an electrical interface electrically coupled to a tendon wire. The Patent Office admits that this is not shown in either Giba or Lemelson. Lemelson describes a medical instrument such as a catheter having a lumen that may contain one or more of any number of operating mechanisms 64 "(an extendible hollow needle 65 is illustrated, but many other operating mechanisms can be used), including such devices as biopsy devices, microwave or RF waveguides, chemical sensors and the like)". Col. 19, lines 18-26. This language does not

describe an electrical interfaces as described in claim 1. Lemelson also describes stiffening member 68 inside lumen 61 which may take the form of a longitudinally-extending tube having one or more longitudinally-extending compartment 69 separated at intervals by wall 70. See col. 19, lines 26-30. Inside each compartment is a quantity of an electrorheological gel and activating electrode 71 and common ground electrode 72. Activating electrode 71 is used to create an electrical potential through wires 66 across a compartment and solidifying the electrorheological gel. The electrical mechanism in Lemelson is electrodes in the electrorheological gel.

There is no motivation in the cited references for an apparatus including an electrical interface electrically coupled to a tendon wire. A possible motivation for the combination of references might be the use of electrical rheological composition to stiffen the catheter of Giba, but it is not apparent that such would require coupling an electrical interface to shim 120 of Giba. No motivation is presented to couple an electrical interface to shim 120 of Giba.

For the above stated reasons, independent claim 1 is not obvious over the cited references. Claims 3-6, 8-9 and 11 depend from claim 1 and therefore contain all the limitations of that claim. For at least the reasons stated with respect to claim 1, claims 3-6, 8-9 and 11 are not obvious over the cited references.

Applicant respectfully requests that the Patent Office withdraw the rejection to claims 1, 3-6, 8-9 and 11 under 35 U.S.C. §103(a).

C. 35 U.S.C. §103(a): Rejection of Claim 7

The Patent Office rejects claim 7 under 35 U.S.C. §103(a) as obvious over Giba in view of Lemelson. Claim 7 depends from claim 1 and therefore contains all the limitations of that claim. For the reasons stated above, claim 7 is not obvious over the cited references. Applicant respectfully requests that the Patent Office withdraw the rejection to claim 7 under 35 U.S.C. §103(a).

D. 35 U.S.C. §103(a): Rejection of Claim 10

The Patent Office rejects claim 10 under 35 U.S.C. §103(a) as obvious over Giba and Lemelson in view of U.S. Patent No. 5,730,741 of Horzewski et al. (Horzewski). Horzewski is cited for teaching the inclusion of a stabilizing member to guide the insertion of the catheter.

Claim 10 depends from claim 1 and therefore contains all the limitations of that claim. Claim 10 is not obvious over the cited references, because the cited references fail to teach or provide any motivation for an apparatus comprising, among other elements, an electrical interface electrically coupled to a tendon wire. In this regard, the arguments noted above are applicable to overcoming the rejection of claim 10. Applicant respectfully requests the Patent Office withdraw the rejection to claim 10 under 35 U.S.C. §103(a).

E. 35 U.S.C. §103(a): Rejection of Claim 12

The Patent Office rejects claim 12 under 35 U.S.C. §103(a) as obvious over Giba and Lemelson in view of U.S. Patent No. 6,009,349 of Mouchawar et al. (Mouchawar). Mouchawar is cited for showing an accelerometer for use in a catheter.

Claim 12 depends from claim 1 and therefore contain all the limitations of that claim. Claim 12 is not obvious over the cited references, because the cited references fail to teach or provide any motivation for an apparatus comprising, among other elements, an electrical interface electrically coupled to a tendon wire. In this regard, the arguments noted above are applicable to overcoming the rejection of claim 12. Applicant respectfully requests the Patent Office withdraw the rejection to claim 12 under 35 U.S.C. §103(a).

F. Allowed Claims 13-27

Applicant acknowledges with appreciation the allowance of claims 13-27.

CONCLUSION

In view of the foregoing, it is believed that all claims now pending patentably define the subject invention over the prior art of record and are in condition for allowance, and such action is earnestly solicited at the earliest possible date. If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2666 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17, particularly, extension of time fees. If a telephone interview would expedite the prosecution of this Application, the Examiner is invited to contact the undersigned at (310) 207-3800.

Respectfully submitted,

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Date:

4/20/05

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I hereby certify that this correspondence is being deposited with the United States Postal Service on the date shown below with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Nedy Calderon

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4/20/05

Date